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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,303	12/02/2003	Paul Gallagher	017887-005920US	5215
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,303	<b>Applicant(s)</b> GALLAGHER ET AL.	
	<b>Examiner</b> Jason M. Borlinghaus	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/11/05 & 11/07/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 11, 23-25, 28, 29, 36-42 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11, 23-25, 28-29, 36-42, 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 - 2, 6 - 8, 11, 23 - 24, 28 - 29, 36-39, 41-42 and 48** are rejected under 35 U.S.C. 103(a) as being anticipated by Barbara (PG Pub 2002/0016769).

**Regarding Claims 1, 2, 5, and 8**, Barbara discloses a computer implemented method transferring funds from an online account associated with a first user (customer transaction account) to a recipient online account (recipient transaction account) (see figure 1), the method comprising:

- receiving a transfer request from the first user (customer), the transfer request including an amount of funds for transfer from the online account (customer transaction account) and identification information for a

recipient of the funds, the identification information including an electronic message address associated with the recipient. (see p. 4, para. 52 - 54 and fig. 3);

- automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient. (see p. 4, para. 55 and fig. 4);
- receiving a response from the recipient wherein the response includes a request by the recipient to open an account (recipient transaction account). (see p. 9, para. 90 and fig. 4);
- opening/identifying the recipient account for the recipient (recipient transaction account). (see p. 4, para. 55);
- transferring said amount of funds from the first account (customer transaction account) to the recipient account associated with the recipient (recipient transaction account). (see p. 3, para. 50);
- wherein the electronic message address comprises an e-mail address, and wherein the electronic message is an e-mail message. (see p. 4, para. 54 – 55 and fig. 3 - 4); and
- further including the step of opening (registering) the first account (customer transaction account) in response to a request from the first user to open the first account . (see p. 3, para. 0050).

Barbara does not teach a method comprising the steps of:

- receiving a response from the recipient accepting or rejecting the transfer of funds wherein the response includes a request by the recipient to open an account; and
- transferring said amount of funds from the first account (customer transaction account) to the recipient account (recipient transaction account) associated with the recipient if the response indicates acceptance.

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

**Regarding Claims 6-7,** Barbara discloses a method comprising the steps of:

- receiving a transfer request from the first user (customer), the transfer request including an amount of funds for transfer from the first online account (customer transaction account) and identification information (e-mail address) for a recipient of the funds, the identification information including an electronic message address for the recipient. (see p. 4, para. 54 and fig. 3);

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- automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient. (see p, 4, para, 55 and fig, 4); and
- transferring said amount of funds from the first account (customer transaction account) to the recipient account (recipient transaction account). (see p. 3, para. 50).

Barbara does not teach a method comprising the steps of:

- wherein the transfer request further includes a request for identity confirmation;
- receiving a response from the recipient accepting or rejecting the transfer of funds wherein the response from the recipient includes identity information responsive to the request for identity confirmation;
- automatically sending the identity information to the first user;
- receiving from the first user an acceptance or a rejection of the identity information;
- transferring said amount of funds from the first account to the recipient account if the response indicates acceptance and if the acceptance of the identity information is received from the first user; and
- wherein the request for identity confirmation includes a query, and wherein the information from the recipient includes an answer to the query.

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial

transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Requesting identity confirmation from the intended recipient of funds, retrieving information to satisfy such request and making the disbursement of funds conditional upon satisfaction is old and well known in the art of banking and financial transactions, especially in regards to checking identity of recipients when cashing check, or when paying with a check and credit card, such as in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability to request identity confirmation of the recipient, to accept such information from the recipient and transfer funds based upon the satisfaction of the identity confirmation, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

**Regarding Claim 11,** Barbara discloses a method:

- wherein the method is implemented in a host server (computer of service provider). (see para. 49 and fig. 1);
- wherein the method is implemented through a URL (enrollment page). (see S1, fig. 2); and

- sending an electronic message. (see p. 4, para. 0055 and fig. 4).

Barbara does not teach a method

- wherein the method is implemented in a host server, and wherein the electronic message includes a URL link to the host server.

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to have modified Barbara to incorporate a URL link to the host server in the electronic message to allow for the recipient of the electronic message to easily and simply connect to and register with the system.

**Regarding Claims 23-24**, further system claims would have been obvious from method claims rejected above, Claims 1 - 2, and are therefore rejected using the same art and rationale.

**Regarding Claims 28 –29**, further system claims would have been obvious from methods claims rejected above, Claims 6 - 7, and is therefore rejected using the same art and rationale.

**Regarding Claim 36**, a method comprising the steps of:

- receiving a transfer request to transfer funds from a first online account associated with a first user (customer transaction account) to a second online account (recipient transaction account) associated with a second user (recipient), wherein the transfer request includes a bank identifier (designation) that identifies a first of the plurality of the affiliate banks (deposit account/checking account/debit account/source account). (see p. 2, para. 17, p. 4, para. 54 and fig. 1 and 3);



- transferring funds from the first online account (customer transaction account) to the second online account (recipient . (“Thus, the customer that registers for the service is able to have funds reside in the transaction account and to transmit funds from that account to other users, such as recipient, once the recipient is also enrolled.” – see p. 3, para. 50); and
- wherein the first affiliate bank (system provider/financial institution) conducts the fund transfer settlement for the transferred funds on behalf of the first user (customer). (see p. 5, para. 60).

Barbara does not teach a method comprising the steps of:

- transferring funds from the first online account to the second online account after the second user has approved the transfer request

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate to condition the transfer of funds upon the acceptance or rejection of such fund transfer by the intended

recipient, as is old and well known, allowing the recipient to enforce their decision concerning their acceptance or rejection of the offered funds.

**Regarding Claim 37**, Barbara discloses a method wherein:

- the settlement includes one of an ACH transaction, a check card transaction and a credit card transaction. (see pp. 3-4, para. 50 and p. 7, para. 73).

**Regarding Claim 38**, Claim 38 recites similar limitations to a portion of Claim 1 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

**Regarding Claim 39**, Claim 39 recites similar limitations to a portion of Claim 2 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

**Regarding Claim 41**, Barbara discloses a method further including:

- the step of receiving a second bank identifier (checking account) from the second user, the second bank identifier identifying one of the affiliate banks (service provider/financial institution) for conducting fund transfer settlement on behalf of the second user. (see p. 4, para. 56 and p. 5, para. 60).

**Regarding Claim 42**, Barbara discloses a method wherein:

- the first and second bank identifiers indicate the same affiliate bank. (see p. 5, para. 60).

**Regarding Claim 48**, Barbara discloses a method wherein:

- the transfer request includes a request from the first user (customer) to pay funds to the second user (recipient). (see p. 4, para. 0054 and fig. 3).

**Claims 3, 25 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbara, as with Claims 1, 23 and 38 above, in view of Saylor (PG Pub 2004/0111370).

**Regarding Claims 3 and 40**, Barbara does not teach a method wherein:

- the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID.

Saylor discloses a method wherein:

- the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID. ("For example, "email" may be replaced with a voice mail or instant messaging." – see p. 18, para. 168 – establishing that instant messaging notification of recipient could be used in place of email notification of recipient. It would, therefore, be inherent in utilizing instant messaging communication that the system request the recipient's user ID in substitution for or in addition to the recipient's email address for instant messaging communication to take place).

It would have been obvious to one of ordinary skill in the art at the time that the invention as made to have modified Barbara to incorporate instant messaging, as was done by Saylor, to allow the system to communicate to the recipient through a variety of electronic means.

**Regarding Claim 25**, further system claim would have been obvious from method claim rejected above and is therefore rejected using the same art and rationale.

### ***Response to Arguments***

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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